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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,074	10/21/2003	David Grabelsky	03-765	6708

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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP  
300 S. WACKER DRIVE  
32ND FLOOR  
CHICAGO, IL 60606

EXAMINER
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TIEU, BINH KIEN

ART UNIT	PAPER NUMBER
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2614

MAIL DATE	DELIVERY MODE
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01/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/690,074

Applicant(s)

GRABELSKY ET AL.

Examiner

/BINH K. TIEU/

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41-69 is/are allowed.
- 6) ☒ Claim(s) 1-25 and 29-40 is/are rejected.
- 7) ☒ Claim(s) 26-28 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/6/05 & 4/25/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, 5, 12, 29-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Oran et al. (US. Pat. #: 7,194,354).

**Regarding claim 1**, Oran et al. ("Oran") teaches a method of configuring a packet based phone for initiating an emergency call in a packet based network, comprising:

receiving an ERL record at a packet based phone, said ERL record being associated with the phone's emergency response location (i.e., a VoIP phone at switch 105, as shown in figure 1 could query the switch 124 which performs a lookup on its geo-location table 310 and return the matching physical coordinates to the querying device, col.10, lines 38-48); and

transmitting from the packet-based phone at least a portion of the ERL record as part of an emergency call setup process (i.e., the VoIP device makes a 911 call, it appends its physical coordinates as obtained from the network switch 124, col.10, lines 49-55).

Regarding claim 2, note col.1, lines 56-59.

Regarding claim 5, note col.10, lines 49-55.

Regarding claim 12, note col.10, lines 49-54.

**Regarding claim 29**, Oran teaches a method of configuring a packet based phone for initiating an emergency call in a packet based network, comprising:

determining an ERI of the packet based phone (i.e., the switch 124 receives a query from a VoIP phone and the switch performs a lookup on its geo-location table 310 and return the matching physical coordinates to the querying device, col.10, lines 38-48); and

transmitting a corresponding ERI record to the packet based phone, said ERI record including parameters enabling the packet based phone to initiate an emergency 911 call (i.e., the VoIP device makes a 911 call, it appends its physical coordinates as obtained from the network switch 124, col.10, lines 49-55).

Regarding claim 30, note col.1, lines 56-59.

Regarding claims 31-33, note col.10, lines 49-55.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 3-4, 6-11, 13-17, 25 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oran et al. (US. Pat. #: 7,194,354) in view of Stumer et al. (Pub. No.: US 2003/0063714).

regarding claim 3, Oran teaches all subject matters as claimed above, except for transmitting Emergency Location Identification Number (ELIN) in the emergency call to a central office. However, Stumer et al. ("Stumer") teaches such feature in paragraph [0046] for a purpose of allowing the operator of a PSAP to call back the calling party.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the feature of transmitting ELIN in the emergency call to a central office, as taught by Stumer, into view of Oran in order to provide the operator of a PSAP to call back the caller.

Regarding claim 4, Oran further teaches the ERL record and among other information being loaded and transmitted from the querying device in a session initiation protocol (SIP) message to the network office 124 (see col.10, lines 49-55). Stumer teaches the ELIN is transmitted in the emergency call. Therefore, combination of Oran and Stumer obviously teaches feature of the ELIN being transmitted in the SIP message.

Regarding claims 6 and 34, Oran further teaches that the ERL record may be transmitted in other types of messages such as Media Gateway Control Protocol (MGCP) or MEGACO, a

call signaling protocol such as H.323. Therefore, it would have been obvious to transmit the ELIN in an SDP contained in a SIP INVITE message or to transmit as a textual message in the body of a SIP OK message...

Regarding claims 7-11 and 13-17, Stumer further teaches limitations of the claims in paragraphs [0022], [0024], [0031], [0038] and [0046]

Regarding claim 25, Stumer further teaches limitations of the claims in paragraphs [0031].

5. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oran et al. (US. Pat. #: 7,194,354) in view of Stumer et al. (Pub. No.: US 2003/0063714) as applied to claims 1 and 12 above, and further in view of Karaul et al. (Pub. No.: US 2002/0024943).

Regarding claims 18-19, Oran and Stumer, in combination, teaches all subject matters as claimed above, except for the features of SIP proxy server and INVITE message. However, Karaul et al. ("Karaul") teaches such features in paragraph [0082] for a purpose of setting up a packet based call.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the feature of SIP proxy server and INVITE message, as taught by Karaul, into view of Oran and Stumer in order to setup a packet based call.

6. Claims 20, 24, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oran et al. (US. Pat. #: 7,194,354) in view of Becker et al. (Pub. No.: US 2005/0007999).

Regarding claims 20, 35-36, Oran fails to teach the feature of determining the emergency response location of the phone based in apart on an IP address of the phone. However, Becker et al. ("Becker") teaches such feature in paragraphs [0032] and [0035] for a purpose of providing the operator of a PSAP to callback the caller.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the feature of determining the emergency response location of the phone based in apart on an IP address of the phone, as taught by Becker, into view of Oran in order to provide the operator of a PSAP to callback the caller.

Regarding claim 24, Becker further teaches limitations of the claim in paragraph [0002].

7. Claims 21 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oran et al. (US. Pat. #: 7,194,354) in view of Brouwer et al. (Pub. No.: US 2004/0057425).

Regarding claims 21, 37-38, Oran fails to teach the feature of determining the emergency response location of the phone based in apart on a MAC address of the phone. However, Brouwer et al. ("Brouwer") teaches such feature in the Abstract's last sentence for a purpose of providing the operator of a PSAP to callback the caller.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the feature of determining the emergency response location of the phone based in apart on an MAC address of the phone, as taught by Brouwer, into view of Oran in order to provide the operator of a PSAP to callback the caller.

8. Claims 22 and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oran et al. (US. Pat. #: 7,194,354) in view of Powers et al. (Pub. No.: US 2004/0160363).

Regarding claims 22, 39-40, Oran fails to teach the feature of determining the emergency response location of the phone based in apart on a serial number of the phone. However, Powers et al. ("powers") teaches such feature in the paragraph [0056] for a purpose of providing the operator of a PSAP to callback the caller.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the feature of determining the emergency response location of the phone based in apart on an serial number of the phone, as taught by Powers, into view of Oran in order to provide the operator of a PSAP to callback the caller.

9. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oran et al. (US. Pat. #: 7,194,354) in view of Knox (Pub. No.: US 2004/0190497).

Regarding claim 23, Oran fails to teach the feature of transmitting an address of a PSTN gateway device for use during an emergency call. However, Knox teaches such feature in the paragraph [0029] for a purpose of routing the emergency call to the desired PSAP.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the feature of transmitting an address of a PSTN gateway device for use during an emergency call, as taught by Knox, into view of Oran in order to route the emergency call to the destination PSAP.



*Allowable Subject Matter*

10. Claims 26-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
11. Claims 41-69 are allowed.
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (571) 272-7510 and E-mail address: [BINH.TIEU@USPTO.GOV](mailto:BINH.TIEU@USPTO.GOV).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (571) 272-7499 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL CUSTOMER SERVICE FOR THE SUBSTITUTIONS OR COPIES.**

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**/BINH K. TIEU/**  
Primary Examiner  
Technology Division 2614

Date: January 2008